

### **Remarks/Arguments**

The present amendment is made response to the non-final Office Action dated March 17, 2009 and identified as Paper No. 20090309. Claims 1-12 are pending, and claims 1, 7, and 8 have been amended. Support for the amended claims can be found, for example, at paragraphs [0025]-[0034].

In the Action, the Examiner rejected claims 1, 6 and 7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 7,016,071 to Hiraishi ("*Hiraishi*"). Claims 2, 3, 5, 8-10 and 11 were rejected under U.S.C. 103(a) as being unpatentable over *Hiraishi* in view of U.S. Patent No. 6,415,341 to Fry ("*Fry*"). Claim 4 was rejected under U.S.C. 35 103(a) as being unpatentable under *Hiraishi* in view of European Patent No. 1,253,511 to Korst ("*Korst*"). Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Hiraishi* in view of *Fry* and in further view of *Korst*.

#### **I. Objection to Claim 8**

The Examiner objected to claim 8 because there are two bullets labeled "(ii)".

Claim 8 has been amended by changing the second referenced bullet labeled "(ii)", to "(iii)", and the bullet labeled "(iii)" to "(iv)". Therefore, Applicant respectfully requests that the objection to claim 8 be withdrawn.

#### **II. 35 U.S.C. § 102(b) Rejections in view of *Hiraishi***

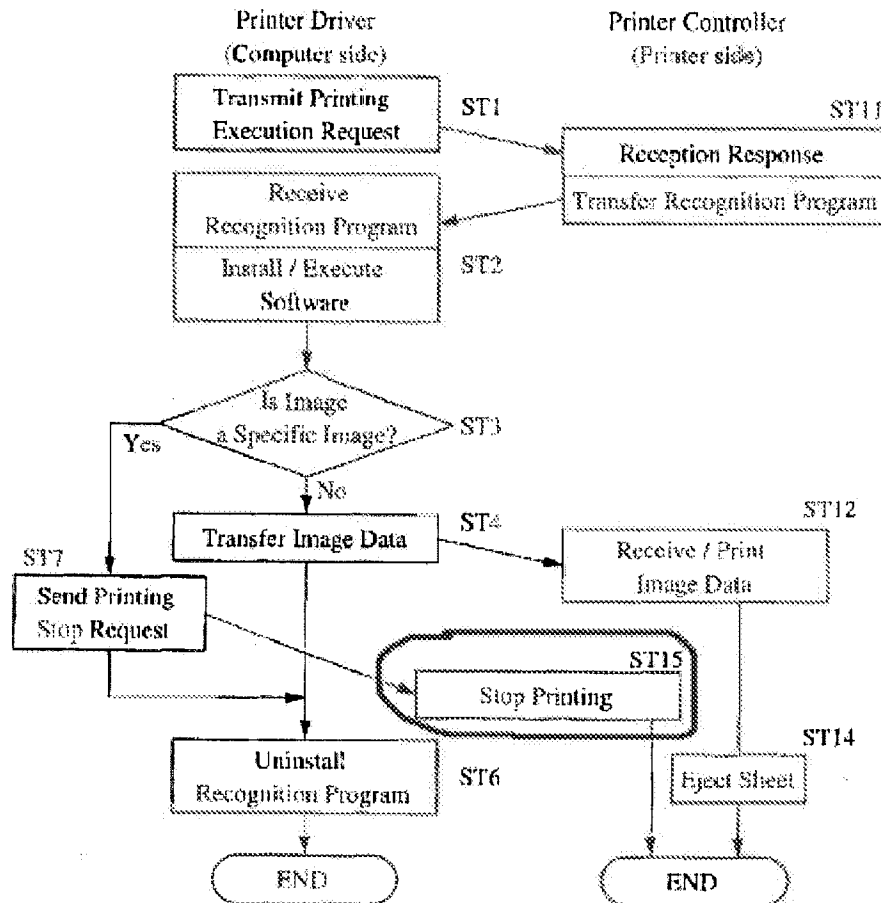
A rejection under 35 USC 102(b) requires that the reference include each and every limitation recited in the claims. MPEP 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Applicant submits that not all of the elements of rejected claims 1, 6, and 7 are disclosed by *Hiraishi*, as further explained below; thus the claims are not anticipated.

In particular, Applicant submits that *Hiraishi* does not teach or suggest the steps of “*suspending the printing of said special effect* in response to determining said triggering byte string is in said input byte stream; *and printing said print data on the output media,*” as required by amended independent claim 1, and the steps of “*suspending the printing of said special effect* for a predetermined number of printer operations in response to determining said triggering byte string is in said input byte stream; *and printing said print data on the output media,*” as required by amended independent claim 7.

In contrast, *Hiraishi* only discloses completely stopping normal printing operations (not just the suspension of printing of a specific image) when a prohibited output item is recognized by the scanning of the document by a recognition program. *See e.g.*, Abstract (“The personal computer executes the received recognition program to carry out recognition. Upon detecting a specific image, the personal computer instructs the printer to ***discontinue the printing operation.***”); col. 2, lines 17-22 (“wherein a recognition process to determine whether or not there is a prohibited output item is carried out using the computer connected to the peripheral device (image input device, image forming device or the like), and in the case *where a prohibited output item is recognized, a normal printing is finally stopped.*”); col. 9, lines 2-19 (referring to Fig. 5, reproduced below — “in the case where a specific image is detected, instead of giving a message such as a warning or the like or carrying out a printout of an altered image, ***the printing process itself is stopped.*** Specifically, with regards to the function of the printer driver 21, a judgment of whether or not an image is a specific image is carried out (ST3), and in the case where an image is a specific image, instead of image data, *a printing stop request is sent out (ST7)*[, and] when a printing stop request is received, ***no printing is carried out (ST15).*** Then, without ejecting a sheet, the ***process is terminated.***”); col. 20, lines 63-65 (“in the case

where the prohibited printing flag is on, it is judged that **printing should not be executed**")

(emphasis added to the text and Fig. 5, reproduced below, by Applicant) .



Thus, *Hiraishi* fails to disclose at least one express claim limitation of each of the rejected claims, and cannot anticipate claims 1, 6, and 7 under 35 USC 102(b) as a matter of law.

### III. 35 U.S.C. § 103(a) Rejections in view of *Hiraishi*

Applicant submits that the proposed combinations (*Hiraishi* in view of *Fry*, *Hiraishi* in view of *Korst*, and *Hiraishi* in view of *Fry* further in view of *Korst*) lack at least one express claim element of claims 2-5 and 8-11, and the Examiner has thus not presented a *prima facie* case of obviousness. See MPEP 2143.03 ("To establish *prima facie* obviousness of a claimed

invention, all the claim limitations must be taught or suggested by the prior art.”). Specifically, the proposed combinations do not cure the deficient showing of *Hiraishi* as discussed above. Thus, none of the proposed combinations render claims 2-5 and 8-11 obvious under 35 U.S.C. § 103.


#### **IV. Extension of Time**

A petition for a two month extension of time along with the appropriate fee has been submitted herewith.

Accordingly, in view of the foregoing amendments as supported by these remarks, the Examiner’s reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant’s attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8515.

Respectfully submitted,

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By:   
George R. McGuire  
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC  
One Lincoln Center  
Syracuse, New York 13202-8530  
(315) 218-8515